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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,359	01/28/2004	Hiroaki Kishioka	Q79-404	1537
65565 SUGHRUE-265550 2100 PENNSYLVANIA AVE. NW WASHINGTON, DC 20037-3213	7590 12/26/2007			
EXAMINER				
DESAL, ANISH P				
ART UNIT		PAPER NUMBER		
1794				
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12/26/2007		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/765,359

**Applicant(s)**

KISHIOKA ET AL.

**Examiner**

ANISH DESAI

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 10/03/07 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/03/07 has been entered.
2. Claims 1, 2, 5, and 6 are pending. Claims 3 and 4 are cancelled.
3. Applicant has asked Examiner to clarify the status of the claims as set forth on The Office Action Summary sheet in the previous Office Action. The status of the claims on The Office Action Summary sheet of the previous Office Action is incorrect and it should be "claims 1, 2, 5, and 6 are pending".
4. Amendment to the specification received on 10/03/07 is entered because it does not add any new matter.
5. All of the previously made art rejections are withdrawn in view of the present amendment and response. However, upon further consideration a new 35 USC Section 103(a) rejection is made based on Kishioka (US 2002/0098352A1) in view of Hitoshi et al. (EP 0930322A2).
6. It is noted that the reference of Ulrich (Re. 24,906) was cited on page 3 of the previous Office action dated 06/18/07, but it was not cited on the form PTO-892. The Examiner is providing PTO-892 form with the aforementioned reference cited on it.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kishioka (US 2002/0098352 A1) in view of Hitoshi et al. (EP 0930322A2).

With respect to claims 1 and 5, the claim preamble is directed to a double-sided pressure sensitive adhesive sheet. Therefore, recitations "sheet to be used in sticking and fixing a touch panel to a display surface of a display device", "adhesive sheet is capable of being adhered substantially entirely on the touch panel, and the other surface is capable of being adhered substantially entirely on the display surface of the display device", "it is repeatedly peelable against at least one surface of the touch panel and the display surface of the display device", and "which is used for fixing a display device to touch panel in the inner touch panel system" (claim 5) are interpreted as an intended use of the pressure sensitive adhesive sheet and they are not part of the structure of the PSA sheet that is claimed. While some of the above listed features are functional in nature, there is no evidence of record to indicate that the adhesive material of the below combined prior art would not have the capability of functioning as claimed.

Kishioka discloses a pressure-sensitive adhesive composition and a pressure-sensitive adhesive sheet that is used to stick and fix an optical film on the display panel of a display device (abstract). As to the claim limitations of double-sided pressure sensitive adhesive tape having at least two pressure-sensitive adhesive layers but does not have a substrate, it is noted that Kishioka discloses "The pressure-sensitive adhesive layer can be constituted of a plurality of layers through another layer or through no another layer" (0065). Moreover, the thickness of the pressure sensitive adhesive layer of Kishioka is generally in the range of from 5 to 500  $\mu\text{m}$ ,

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preferably from 10 to 100  $\mu\text{m}$  (0064). As to the claim requirement of "Wherein the respective pressure-sensitive adhesive layers each comprise an acrylic polymer containing a (meth)acrylic acid alkyl ester in which alkyl...dodecyl (meth)-acrylate", the pressure sensitive adhesive of Kishioka is formed of acrylic polymer comprising monomer components of the aromatic ring-containing copolymerizable monomers, the copolymerizable monomers containing no aromatic ring, the monomer for modification etc. (0043). As monomers containing no aromatic ring, Kishioka discloses monomers such as alkyl (meth)acrylates wherein the alkyl group has from one to 18 carbons. These monomers are methyl (meth)acrylate, ethyl(meth)acrylate etc. (see 0038-0039).

The difference between the claimed invention and the prior art of Kishioka is that Kishioka is silent with respect to teaching "the proportion of the major monomer component constituting each pressure-sensitive adhesive layer is 80% by weight or more based on the whole amount of monomer components.". However, the weight percent of such monomers are taught by Hitoshi, specifically in the abstract and at 0008. Hitoshi discloses a pressure-sensitive adhesive sheet based on acrylic adhesives that is useful as fixing tape, masking tapes, etc. for electronic parts (0002-0003). The adhesive tape of Hitoshi comprises from 70 to 100% by weight of a (meth)acrylic acid alkyl ester having on average 2 to 14 carbon atoms of the alkyl group based on the total amount of the monomers (0008). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the proportion of the major monomer component in the amount of 80% by weight or more in the pressure-sensitive adhesive layer, motivated by the desire to form the pressure-sensitive adhesive tape

having excellent in foaming resistance, low gas-out property, the discoloring resistance, and transparency.

As to the claim limitations of the PSA having optical isotropy, at least one pressure-sensitive adhesive layer of the pressure-sensitive adhesive layers of both outer sides has a 180°-peeling adhesive strength of no more than 5.0 N/20 mm, and repeatedly peelable function, these limitations are believed to be present in the double-sided pressure sensitive adhesive tape of Kishioka (US 2002/0098352 A1) and Hitoshi et al. (EP 0930322A2) taken together. The support for the Examiner's position is based on the fact that the double-sided adhesive tapes of Kishioka as modified by Hitoshi and that of Applicant are structurally and compositionally equivalent. Specifically, the double-sided pressure sensitive adhesive tapes of Kishioka as modified by Hitoshi and Applicant comprise at least two pressure-sensitive adhesive layers wherein the PSA layers comprise an acrylic polymer as set forth in claim 3. Therefore, the presently claimed limitations of the PSA having optical isotropy, at least one pressure-sensitive adhesive layer of the pressure-sensitive adhesive layers of both outer sides has a 180°-peeling adhesive strength of no more than 5.0 N/20 mm, and repeatedly peelable function would be present. The burden is shifted to Applicant to prove it otherwise (*In re Fitzgerald*, 205 USPQ 594).

8. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okabe et al. (abstract of JP 07-105781) in view of Kishioka (US 2002/0098352A1) and Hitoshi (EP 0930322A2).

Okabe discloses a transparent touch panel structure wherein the transparent touch panel and the display panel is stuck to each other by an acrylic adhesive with good transparent property (see abstract). Okabe is silent with respect to teaching the double-sided adhesive tape as presently claimed in claims 1 and 2. However, the inventions of Kishioka and Hitoshi are previously disclosed in Section 6 above and they are equally applicable here. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the double-sided adhesive tape of Kishioka and Hitoshi in the invention of Okabe, motivated by the desire to provide suitable tape that can bond the display device and the touch panel.

#### ***Response to Arguments***

9. Applicant's arguments received on 10/03/07 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

APD

/Terrel Morris/

Terrel Morris

Supervisory Patent Examiner

Group Art Unit 1794